Remarks

Claims 1-11 are pending in the above-identified application. The Examiner allowed claims 1-5, objected to claim 7, rejected claim 11 under 35 U.S.C. § 112, rejected claims 6, 8, 9 under 35 U.S.C. § 102(e), and rejected claim 10 and 11 under 35 U.S.C. § 103(a).

Embodiments of the present invention allow a packet-based telephony network to hand off a call to a circuit-switched telephony network when the call invokes features that are not supported by the packet-based network, but are implemented by the circuit-switched network. The bearer channel for the call is initially transmitted from an access tandem or end office to a media gateway, such as a packet voice gateway, where the call is transmitted onto a packet-based network, such as an I P-based connection or an ATM transport. Meanwhile, an initial address message associated with the call is received by a call processing entity such as a connection gateway, which forwards the message to a feature server call processing entity within the packet network. The feature server determines from the initial address message the type of feature invoked by the call.

If the call invokes a feature that is not supported by the feature server, the feature server conveys a routing message to a terminating connection gateway, indicating that the call should be routed to a legacy circuit-switched switching system for processing. The routing message may include a trunk selection parameter, whereby the feature server specifies one of a plurality of voice trunks in a shared trunk group upon which the call should be routed to the legacy switch. Because the calls routed to the circuit-switched switching system are partitioned based upon the type of feature invoked, the switching system requires no further input or interaction with the packet-based network media gateway. The calls are

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received as if they were coming directly from the access tandem. Finally, the circuit-switched telephony network provides the invoked feature. The call may then be either routed to its destination via the circuit-switched network, or sent back onto the packet-based network for routing to its destination.

Claim Rejections - 35 U.S.C. §112:

MPEP § 2173.04 states:

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

In the present Office Action, the Examiner rejected claim 11 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. According to the Examiner, the limitation "selecting a destination call processing entity within the packet network by a first call processing entity" is not supported by the specification. The Examiner then concludes that it would not have been able one skilled in the art to which it pertains to make and use the invention.

The Examiner also rejected claim 11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The Examiner alleged that claim 11 is indefinite because it is not clear which elements in fig. 1 the limitations "destination call processing entity" and "call processing entity" refer to. The Examiner asked: is the "destination call processing entity" the Feature server 170; and is the "call processing entity" the CG 180?

In claim 11 a trunk selection parameter is conveyed from the first call processing entity to the selected destination call processing entity. On page 12 of the specification, lines 1-3, it states: "In the embodiment of Figure 1, when Feature Server 170 detects that a call requires a feature that it cannot provide, it determines a TSP associated with the required feature. The TSP is then sent out to Connection Gateway 180." On page 11, line 20, the TSP is defined to be the trunk selection parameter. Therefore, it clear from the specification that the first call processing entity is the feature server 170 and that the destination call processing entity is the connection gateway.

Also, on page 9 of the specification, lines 8-10, it states, "In the embodiment of Figure 1, Feature Server 170 signals one or more packet network connection gateways, which in turn control associated PVGS, to direct the call through the packet network." Therefore, the limitation "selecting a destination call processing entity within the packet network by a first call processing entity" is supported by the specification.

The rejection of claim 11 under 35 U.S.C. 112 is respectfully traversed and the Examiner is respectfully requested to reconsider the rejection of claim 11.

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Claim Rejections - 35 U.S.C. §103:

MPEP §2129 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631,2 USPQ2d 1051,1053 (Fed. Cir.1987). "The identical invention must be shown in as complete detail as is contained in the ... claim. "Richardson v. Suzuki Motor Co., 868 F.2d 1226,1236,9 USPQ2d 1913,1920 (Fed. Cir.1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831,15 USPQ2d 1566 (Fed. Cir.1990).

The Examiner rejected claims 6, 8, 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,606 to Civanlar et al.

The Examiner alleged that regarding claim 6, Civanlar et al disclose a system having: Forwarding to a server signaling associated with the initial of the call (Fig. 1, 3; col. 4, line 53-col. 5, line 5); Determining that the call invokes a feature that cannot be provided by the packet-based network (Fig. 1, 3; col. 3, lines 20-47; col. 4, lines 57-63); Routing the call from the packet-based network to a circuit-switch network (Fig. 1, 3; col. 5, lines 32-42); Processing the call on the circuit-switch network (Fig. 1, 3; col. 5, lines 45-47).

Regarding the first step of the method in claim 6, the Examiner has relied on the following in Civanlar et al. The service request in step 303 also includes client information (e.g., client ID, phone number, billing account), which is used by the server to process the

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service request. According to illustrative embodiments, each client may have a pre-established account in a database at a server location. The database entry for a given client account may include the client's login/password, phone number, billing account and other information deemed necessary to properly process service request and to deliver and bill for information delivery or other services provided by the server.

In the specification of the present application, on page 9 lines 21-23, and on page 10 lines1-3, it is explained that if Feature Server 170 determines, through its evaluation of the SS7 IAM message received from Connection Gateway 160, that a call requires a feature which it cannot provide, Feature Server 170 signals Connection Gateway 180 indicating that the call should be handed off to the legacy circuit-switched network. The call is routed from packet network 55 to PVG 60, and Connection Gateway 180 sets up a circuit switched call from PVG 60 to legacy circuit switch 70 on shared trunk group 65.

Claim 6 claims forwarding to a packet network server signaling associated with the initiation of the call. Since Civanlar et al. does not teach <u>forwarding to a packet network server signaling associated with the initiation of the call,</u> Civanlar et al. does not anticipated the present invention as set forth in claim 6.

Regarding the rejection of claim 8, the Examiner states that Civanlar et al disclose the step of assessing the initial address message (Col. 3, lines 20-30). However, since claim 8 is a dependent claim that includes all the limitations of the independent claim 6, upon which it depends, claim 8 is also not anticipated by Civanlar et al. Dependent claim 8 is believed allowable for the same reasons as the related independent claims, as well as its own additional characterizations.

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Regarding the rejection of claim 9, the Examiner states that Civanlar et al disclose that the server assesses the client's account for phone number and for connecting the call (Col. 4, line64-col. 5, line 5; col. 5, lines 39-44). The Examiner understands that the phone number is a trunk selection parameter; therefore it is inherent that Civanlar et al disclose assigning a trunk selection parameter corresponding to the feature invoked by the call. The Examiner also stated that Civanlar et al further disclose routing the call onto a trunk (through modem 2) among a plurality of trunks based on the trunk selection parameter (fig. 2). However, since claim 8 is a dependent claim that includes all the limitations of the independent claim 6, upon which it depends, claim 9 is also not anticipated by Civanlar et al. Dependent claim 9 is believed allowable for the same reasons as the related independent claims, as well as its own additional characterizations.

Therefore, the rejection of claims 6, 8, 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,606 to Civanlar et al. has been overcome, and the Examiner is respectfully requested to reconsider these rejections.

Claim Rejections - 35 U.S.C. §103:

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 states:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Civanlar et al as applied to claim 6 above, and further in view of U.S. Patent No. 6,411,704 to Pelletier et al. According to the Examiner, Civanlar et al disclose routing the call to a second packet gateway (server N) for further transmission via the packet-based network (Fig. 1, 3; col. 5, lines 35-38). The Examiner admits that Civaniar et al fail to disclose implementing the invoked feature on an SS7 network. The Examiner then cites Pelletier et al as disclosing that using SS7 for controlling a PSTN network is well know (Col. 4, lines 2557). The Examiner then concludes that it would have been obvious to a person having ordinary skill in the art by the time the invention was made to implement the invoked feature on an SS7 network in the communication system in figure 2 taught by Civanlar et al. A skilled artisan would have been motivated to so in order to control the PSTN parts of the system.

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However, since claim 10 is a dependent claim that includes all the limitations of the independent claim 6, upon which it depends, claim 10 is not unpatentable over Civanlar et al as applied to claim 6 above, and further in view of U.S. Patent No. 6,411,704 to Pelletier et al. Dependent claim 10 is believed allowable for the same reasons as the related independent claim, as well as its own additional characterizations. No combination of the cited prior art would result in the claimed invention of claim 10, because of the arguments set forth regarding claim 6.

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Civanlar et al. The Examiner argued: Conveying a trunk selection parameter from the first call processing entity to the selected destination call processing entity (Fig. 1, 3; col.4, lines 52-col.5, line 6); Routing the call onto a packet switched trunk based on the t@ selection parameter (Fig.1, 3). The Examiner states that Civanlar et al fail to disclose that the destination call processing entity is connected to a plurality of circuit switched trunks. The Examiner then alleges that it would have been obvious to a person having ordinary skill in the art by the time the invention was made to further modify the destination call processing entity (server) taught by Civanlar et al by connecting it to a plurality of circuit switched trunks. A skilled artisan would have been motivated to so in order to increase the amount of client 100 because serving only one client 100 is a waste of resource and not reliable.

To establish a prima facie case of obviousness, the Examiner must demonstrate all of the following elements: 1) suggestion or motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to combine the reference teachings; 2) reasonable expectation of success found in the prior art; and 3) the prior art references (combined) must teach or suggest all of the claim limitations. The prima facia case of

obviousness determination was improperly made out. The Examiner has not demonstrated all the elements of the prima facia case. Thus, the opinion of obviousness is deficient and the Applicants are deserving of a patent.

The prima facie case requires that the reference teachings appear to have suggested the claimed subject matter. In re Rinehart, 189 USPQ 143, 147 (CCPA, 1976). The Examiner must explain why the prior art would appear to show the claimed subject matter and not simply the general aspects of the invention. Id. More specifically, the Examiner has not shown why Civanlar et a. would suggest modifying the destination call processing entity (server) by connecting it to a plurality of circuit switched trunks.

Therefore, the rejections of claims 10 and 11 under 35 U.S.C. § 103 have been overcome, and the Examiner is respectfully requested to reconsider these rejections.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, arguendo, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Reconsideration and withdrawal of the rejections is therefore respectfully requested. The Examiner has allowed claims 1-5. In view of the above remarks, allowance of all claims pending is respectfully requested.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited.

Respectfully submitted,

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Dated: June 19, 2003

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